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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,100	03/26/2001	Rabindranath Dutta	AUS920010152US1	7732

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,100

Applicant(s)

DUTTA ET AL.

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-25 are pending in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 8-12 and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsunenari Patent Application Publication US 2002/0013744.

Referring to claim 1. Tsunenari discloses a method for processing a return of an item purchased from a selling merchant by a remote customer, said method comprising (abstract):

- Receiving an order for said item from said customer, said order including customer-related information (paragraph 0013 through paragraph 0018);
- Storing said customer-related information in a storage device;
- Sending said item to said customer by said selling merchant (paragraph 0013 through paragraph 0018);
- Receiving a return communication from said customer requesting a return of said item to aid selling merchant (Fig. 8 and Fig. 10G);
- Retrieving said customer-related information from said storage device; and

- Sending a shipping communication including portions of said customer-related information to said customer, said shipping communication identifying a receiving entity other than said selling merchant to whom said item is to be returned (Fig. 2A, Fig. 10H and Fig. 10I).

Referring to claim 2. Tsunenari further discloses a method including receiving a return receipt notice from said receiving entity when said item has been received by said receiving entity (paragraph 0104).

Referring to claims 8-10. Tsunenari further discloses a method wherein:

- Said receiving of said return request and said sending of said shipping communication are accomplished by email communication (Fig. 2A and Fig. 10D);
- Said return receipt notice is accomplished by email (Fig. 2A and Fig. 10D); and
- Said notice of said crediting is accomplished by email (paragraph 0077).

Referring to claims 11-12. Claims 11-12 are rejected under the same rationale as set forth above in claims 1-2.

Referring to claims 18-20. Claims 18-20 are rejected under the same rationale as set forth above in claims 8-10.

Referring to claims 21-22. Claims 21-22 are rejected under the same rationale as set forth above in claims 1-2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7, 13-17 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunenari Patent Application Publication US 2002/0013744 in view of Siegel Patent Application Publication US 2001/0032147.

Referring to claims 3-7. Tsunenari does not expressly disclose a method wherein said method further includes:

- Charging a designated customer account after receiving said order;
- Crediting said customer account after receiving said return receipt notice from said receiving entity;
- Effecting an auction of said item following said receiving of said return communication from said customer, said receiving entity being a winner of said auction; and
- Maintaining a database for storing information concerning said customer, said item and said receiver, said database being updated upon receipt of an order, a return request or a return receipt notice.

Siegel discloses a method wherein said method further includes:

- Charging a designated customer account after receiving said order (Siegel: claim 20);

- Crediting said customer account after receiving said return receipt notice from said receiver (paragraph 0037);
- Effecting an auction of said item following said receiving of said return communication from said customer, said receiver being a winner of said auction (paragraph 0009); and
- Maintaining a database for storing information concerning said customer, said item and said receiver, said database being updated upon receipt of an order, a return request or a return receipt notice (paragraph 0009 and paragraph 0037).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Tsunenari to have included the limitations of Siegel as discussed above because upon returning unwanted purchases consumers generally expect to immediately receive cash or credit for their returns (Siegel: paragraph 003).

Furthermore, the systems and method of Tsunenari is enabled to be used to effect product return for any reason, such as product service, product repair, customer dissatisfaction, etc. Various modifications are possible (Tsunenari: paragraph 0126).

Referring to claims 13-17. Claims 13-17 are rejected under the same rationale as set forth above in claims 3-7.

Referring to claims 23-25. Claims 23-25 are rejected under the same rationale as set forth above in claims 3-7.

Response to Arguments

Applicant's arguments filed on February 9, 2004 have been fully considered but they are not persuasive.

The Applicant argues that Tsunenari does not disclose, "receiving an order" and "sending said item."

The Examiner notes, the independent claims of the instant application do recite the step of receiving an order from a selling merchant and the step of the selling merchant sending said item to the customer. There is not a disclosure in the claims of the instant application that explicitly links the selling merchant with the return communication. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner further notes, paragraph 0032 of Tsunenari defines "Manufacturer" means as the person or entity, organizing and authorizing the consumer product return. In preferred embodiments, the entity, organization and authorizing the consumer product return is, in fact, the entity that actually manufactured the product. Tsunenari discloses a system wherein a product is returned to the manufacturer from which it was purchased. In order for a product to be returned, inherently it would have to have been purchased via a received order, followed by the transfer of the product to the customer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

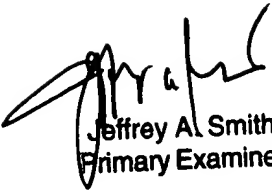
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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March 16, 2004



Jeffrey A. Smith
Primary Examiner